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PATENT
Docket No. 110.02040101

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appellant(s): DELUGA et al.)	Group Art Unit: 1754
)	
Serial No.: 10/676,324)	Examiner: Paul A. Wartalowicz
Confirmation No.: 6481)	
)	
Filed: September 30, 2003)	
)	
For: <u>PRODUCTION OF HYDROGEN FROM ALCOHOLS</u>)	

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Commissioner for Patents
Mail Stop AF
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Appellants hereby request a Panel Review of the final rejection mailed July 21, 2006, in the above-identified application. No amendments are being filed with this request. This request is being filed with a Notice of Appeal.

In the final rejection mailed July 21, 2006, the Examiner rejected under 35 U.S.C. §103(a) claims 1-7, 13-21, 26-30, 35-37, 42-45, and 50 as being unpatentable over Maruko (CA 2323728) in view of Krummenacher et al. ("Catalytic Partial Oxidation of Higher Hydrocarbon at Millisecond Contact Times: Decane, Hexadecane, and Diesel Fuel"); claims 8-12, 22-24, 31-33, 38-40, and 46-49 as being unpatentable over Maruko in view of Krummenacher et al. as applied to the claims above and further in view of Anzai et al. (2003/0060364 A1); claims 1-24, 26-33, 35-40, and 42-50 as being unpatentable over Anzai et al. in view of Krummenacher et al. and Hu et al. (U.S. Patent No. 5,597,771); and claims 1-24, 26-33, 35-40, and 42-50 as being unpatentable over Anzai et al. in view of Maruko and Krummenacher et al.

In summary, for all of the above recited rejections, the Examiner relied on, among other documents, **Krummenacher et al.** ("Catalytic Partial Oxidation of Higher Hydrocarbon at Millisecond Contact Times: Decane, Hexadecane, and Diesel Fuel").

The review is requested for the following reasons:

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THE LACK OF CLARITY OF THE REJECTION IS CLEAR ERROR

Two documents identified as Krummenacher et al. ("Catalytic Partial Oxidation of Higher Hydrocarbon at Millisecond Contact Times: Decane, Hexadecane, and Diesel Fuel") were listed on a 1449 form submitted with an Information Disclosure Statement filed January 14, 2004 by Appellants. Thus, the record is not clear as to which Krummenacher et al. document the Examiner is relying on for the present rejection. The lack of clarity was noted in the Response submitted by Appellants on September 6, 2006 (e.g., page 2, second paragraph addressing the Rejections under 35 U.S.C. §103), but the Examiner has failed to clarify the rejection.

Appellants cannot fairly address the rejection when the art relied upon is not properly identified by the Examiner. In the event that the present Pre-Appeal Brief Request for Review does not result in allowance of the present application, the Panel is requested to remand the application to the Examiner to remedy the deficiencies of the present rejection.

THE CITATION OF KRUMMENACHER ET AL. AS ART AGAINST THE PRESENT APPLICATION IS CLEAR ERROR

In the Response submitted by Appellants on September 6, 2006 (e.g., page 2, second paragraph addressing the Rejections under 35 U.S.C. §103), Appellants noted that although it is not clear on the record as to which Krummenacher et al. document the Examiner is relying, both documents were available or published in 2003. The present application claims priority to U.S. Provisional Application Serial No. 60/415,072, filed October 1, 2002. Appellants further asserted that because Krummenacher et al. published after the claimed priority date of the present application, Krummenacher is not available as art under 35 U.S.C. §102 and/or §103 against the present application, and the above-recited rejections under 35 U.S.C. §103 are moot.

In the Advisory Action mailed September 21, 2006, the Examiner replied by asserting that Krummenacher et al. qualifies as prior art, alleging that the provisional application does not provide adequate support under 35 U.S.C. §112, first paragraph, for the most recently added claim limitations. Specifically, in the Amendment and Response submitted April 24, 2006, claim 1 was amended to recite "forming a film of a composition . . . on a wall of a reactor; [and]

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vaporizing the composition;" and claims 18, 28, 35, and 42 were amended to recite "forming a film of the feed gas on a wall of a reactor; [and] vaporizing the feed gas."

Appellants earnestly disagreed with the Examiner's assertion, and submitted a Response on October 12, 2006, pointing to exemplary portions of the specification and figures of U.S. Prov. Application Ser. No. 60/415,072, that clearly support the claim language noted by the Examiner. In brief, page 3 of the Response submitted October 12, 2006 pointed to exemplary support for the noted claim language including the paragraph at page 4, lines 26-33 of U.S. Prov. Application Ser. No. 60/415,072 (describing an embodiment including a fuel injector apparatus to introduce the feed gas to the reactor); the description of Figure 2 on page 3, lines 1-2 of U.S. Prov. Application Ser. No. 60/415,072 (reciting a "[r]epresentative apparatus for partial oxidation of ethanol using a Fuel Injector apparatus to vaporize the feed gas"); and an annotated copy of Figure 2 of U.S. Prov. Application Ser. No. 60/415,072 that was attached as EXHIBIT A (illustrating, among other things, the formation of a "[t]hin film" on a wall of the reactor, as highlighted in the annotated copy). Appellants respectfully submit that the present claims are fully supported by U.S. Prov. Application Ser. No. 60/415,072 as a whole, and particularly, for example, by the portions of the specification and figures noted herein above. Appellants respectfully request that the Panel review U.S. Prov. Application Ser. No. 60/415,072 **as a whole** to find that the present claims are entitled to the claimed priority date of October 1, 2002.

In the Advisory Action mailed December 11, 2006, the Examiner replied by asserting that the arguments presented in the Response submitted October 12, 2006 were not persuasive for at least the following reasons.

First, the Examiner asserted that "regarding the cited paragraph: the citation from the provisional application describes a permissible apparatus used in the method of the invention. There is no teaching or suggestion that this apparatus describes the invention of the applicant" (page 2 of the Advisory Action mailed December 11, 2006). Appellants respectfully traverse the Examiner's assertion.

Appellants respectfully submit that the Examiner's discussion of whether the provisional application describes a "permissible apparatus" or teaches or suggests that "this apparatus describes the invention of the applicant" is anaposite to the determination of whether the

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provisional application is adequate to satisfy the written description requirement of 35 U.S.C. §112, first paragraph.

"To satisfy the written description requirement, a patent specification must describe the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention." M.P.E.P. §2163(I). "What is conventional or well known to one of ordinary skill in the art need not be disclosed in detail. . . . If a skilled artisan would have understood the inventor to be in possession of the claimed invention at the time of filing, even if every nuance of the claims is not explicitly described in the specification, then the adequate description requirement is met." M.P.E.P. §2163(II)(A)(3)(a).

Appellants respectfully submit that it would be clear to one of skill in the art, in view of U.S. Prov. Application Ser. No. 60/415,072 as a whole, that Appellants had possession of a process that includes "forming a film of a composition . . . on a wall of a reactor; [and] vaporizing the composition" (e.g., claim 1); and "forming a film of the feed gas on a wall of a reactor; [and] vaporizing the feed gas" (e.g., claims 18, 28, 35, and 42).

Second, the Examiner asserted that "regarding the figure: There is no evidence that a thin film is formed on the apparatus, as it is in presently [*sic*] the claimed method. Further, there is no evidence that the spray forms the film on the surface of the reactor. The 'thin film' on the figure is not correlated with any method limitations in the provisional application." (Page 2 of the Office Action mailed December 11, 2006). Appellants respectfully traverse the Examiner's assertion.

Appellants are unclear as to the Examiner's intent for alleging lack of "evidence." To the extent that the Examiner is alleging that U.S. Prov. Application Ser. No. 60/415,072 lacks enablement for the present claims to satisfy the requirements of 35 U.S.C. §112, first paragraph, Appellants respectfully disagree.

"A specification disclosure which contains a teaching of the manner and process of making and using an invention in terms which correspond in scope to those used in describing and defining the subject matter sought to be patented must be taken as being in compliance with the enablement requirement of 35 U.S.C. 112, first paragraph, unless there is a reason to doubt

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the objective truth of the statements contained therein which must be relied on for enabling support." M.P.E.P. §2164.04.

Appellants respectfully submit that U.S. Prov. Application Ser. No. 60/415,072 adequately teaches the manner and process of making and using the presently claimed invention. Notably, the Examiner has not provided any reason to doubt the objective truth of the disclosure provided in U.S. Prov. Application Ser. No. 60/415,072.

In view of the remarks presented herein, Appellants respectfully submit that U.S. Prov. Application Ser. No. 60/415,072 adequately supports the present claims to satisfy the requirements of 35 U.S.C. §112, first paragraph.

For at least these reasons, Appellants respectfully submit that the rejection of claims 1-24, 26-33, 35-40, and 42-50 under 35 U.S.C. §103(a) is moot.

Summary

For the foregoing reasons, Appellants respectfully request that the Panel review and reverse the final rejection mailed July 21, 2006, in the above-identified application, and that a Panel Decision allowing the application on the existing claims be issued.

Respectfully submitted

By

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December 21, 2006**CERTIFICATE UNDER 37 CFR §1.8:**

The undersigned hereby certifies that the Transmittal Letter and the paper(s), as described hereinabove, are being transmitted by facsimile in accordance with 37 CFR §1.6(d) to the Patent and Trademark Office, addressed to Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450,

on this 21 day of DEC, 2006, at 1:30 pm (Central Time).

By: Name: Sandy Truhart